

Remarks

This application has been reviewed in light of the Office Action of August 14, 2002. Claims 1-16 are pending. Claims 1-6 are rejected, and claims 7-16 are allowed. In response, claim 17 is added, a Petition for Consideration of References in an IDS and Concise Explanation of their Relevance is submitted herewith, and the following remarks are submitted. Reconsideration of this application, as amended, is requested. The arguments set forth herein are not applied to allowed claims 7-16.

Applicant submits that the present rejection was prematurely made final, and asks that its finality be withdrawn so that the present amendment may be entered and the two German language references may be considered and made of record. There are two grounds underlying the request to withdraw the finality of the rejection.

First, claim 1 is rejected on a new ground of rejection. This new ground of rejection was not necessitated by any claim amendment, as claim 1 was not previously amended.

Second, the basis for making the new rejections final is stated in the first paragraph on page 6 of the Office Action. Applicant submits that the grounds set forth for making the rejection final, "MPEP 609(B)(2)(i)" (and believed to actually be MPEP 609(B)(2)(a)(i)) in fact identify a situation where "Final Rejection is Not Appropriate", see the title of the MPEP section. The IDS submitted July 22, 2000 was accompanied by the sec. 1.97(e) statement because the new references had been received in the prior three months, and no fee was charged under 37 CFR 1.17(p). Thus, there was a new ground of rejection based on one of these references (Harootian) that was not necessitated by any amendment by Applicant (claim 1 was not previously amended).

Applicant asks that the Examiner withdraw the finality of the rejection, enter the present Amendment, and consider and make of record the two German references.

Applicant responds to the rejections set forth in the Office Action of August 14, 2002.

Claims 1-5 are rejected under 35 USC 103 over Harootian, Jr. '373 in view of Goff '965. Applicant traverses this ground of rejection.

Claims 1-5 are concerned with the problem of imaging detectors, wherein an image is sensed. See the Background, the remainder of the application, and claim 1, reciting "A sensor system for viewing light energy from a scene, comprising: a detector which converts incident light energy into an electrical signal, the detector including an imaging detector array..." [emphasis added]. Goff does not deal with this subject and problem at all, and is accordingly nonanalogous art. Goff relates to sensing the light energy at different wavelengths of a flame 14, not imaging the flame 14. Stated alternatively, Goff is not within the scope and content of the prior art that may be used in forming a sec. 103 rejection. Its teachings are therefore not properly combined with the teachings of Harootian. To be analogous art and properly used in forming a sec. 103 rejection, a reference must be concerned with the same problem as another reference and the claims which are being addressed. See, for example, Medtronic, Inc. v. Cardiac Pacemaker, Inc., 220 USPQ 97, 104 (Fed. Cir. 1983), stating: "Faced with a rate-limiting problem, one of ordinary skill in the art would look to the solutions of others faced with rate-limiting problems." Goff has nothing at all to do with "A sensor system for viewing light energy from a scene, comprising: a detector which converts incident light energy into an electrical signal, the detector including an imaging detector array...", and therefore is not properly within the scope of the prior art. It is therefore not properly applied in rejecting the present claims.

The rejection is based upon combining the teachings of Harootian and Goff, to suggest that an optical train would be inserted between one of the optical devices and the end of the optical fiber bundle. The approach of Harootian is based upon interconverting between two imaging devices 9 whose images are already pixelated. The conversion of Harootian between the two imaging devices 9 and 9 of his Figure 1 involves a pixel-to-pixel coupling of different formats. Harootian specifically states and illustrates that each end of the optical fiber bundle and the individual optical fibers is respectively sized and shaped to correspond in a facing relation to the entire face and to the pixels of the respective facing imaging device, see col. 2, lines 11-19 and col. 3,

lines 3-14, and Figure 1. There is no need for any optical train in Harootian, and any such optical train would adversely affect performance by interfering with this areal and pixel correspondence between the two imaging devices, with the image being carried through the optical fiber bundle. The presence of an optical train would alter the approach of Harootian so that this interconversion would not be possible.

MPEP 2143.01 provides that, in constructing a sec. 103 rejection, the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. MPEP 2143.02 requires that, in combining the teachings of two references, there must be a reasonable expectation of success in the combination. Both of these mandates would be violated in the proposed approach of inserting an optical train into the structure taught by Harootian.

The present rejection presents a hindsight reconstruction based upon unrelated references, which is technically unsupported and is legally improper. The case authority and the MPEP provide guidance on this point. The present rejection is a sec. 103 combination rejection. It is well established that a proper sec. 103 combination rejection requires more than just finding in the references the elements recited in the claim (but which was not done here). To reach a proper teaching of an article or process through a combination of references, there must be stated an objective motivation to combine the teachings of the references, not a hindsight rationalization in light of the disclosure of the specification being examined. MPEP 2143 and 2143.01. See also, for example, In re Fine, 5 USPQ2d 1596, 1598 (at headnote 1) (Fed.Cir. 1988), In re Laskowski, 10 USPQ2d 1397, 1398 (Fed.Cir. 1989), W.L. Gore & Associates v. Garlock, Inc., 220 USPQ 303, 311-313 (Fed. Cir., 1983), and Ex parte Levengood, 28 USPQ2d 1300 (Board of Appeals and Interferences, 1993); Ex parte Chicago Rawhide Manufacturing Co., 223 USPQ 351 (Board of Appeals 1984). As stated in In re Fine at 5 USPQ2d 1598:

"The PTO has the burden under section 103 to establish a prima facie case of obviousness. [citation omitted] It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge

generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

And, at 5 USPQ2d 1600:

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Following this authority, the MPEP states that the examiner must provide such an objective basis for combining the teachings of the applied prior art. In constructing such rejections, MPEP 2143.01 provides specific instructions as to what must be shown in order to extract specific teachings from the individual references:

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

\* \* \* \* \*

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)."

\* \* \* \* \*

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were

individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd.Pat.App.& Inter. 1993)."

Here, there is set forth no objective basis for combining the teachings of the references in the manner used by this rejection, and selecting the helpful portions from each reference while ignoring the unhelpful portions. An objective basis is one set forth in the art or which can be established by a declaration, not one that can be developed in light of the present disclosure. The rationale urged in the explanation of the rejection, "to increase the detecting efficiency of the fiber optic/imaging array device" is technically inapplicable and incorrect. If the rejection is maintained, Applicant asks that the Examiner set forth the objective basis found in the references themselves or otherwise established to be known in the art, for combining the teachings of the references. Applicant requests that the Examiner identify the location of the proposed placement of an optical train into the structure of Harootian and explain why that would not interfere with the operation of the device described by Harootian.

Applicant asks that the Examiner reconsider and withdraw this ground of rejection.

Claim 6 is rejected under 35 USC 103 over Harootian in view of Goff, and further in view of McKinley.

Applicant incorporates the prior discussion of parent claim 1.

McKinley teaches remapping for photolithography, laser ablation, and the like to control intensity distribution (col. 1, lines 5-8). McKinley has no relation to imaging sensors. Accordingly, McKinley is nonanalogous art, and the prior discussion of nonanalogous art is incorporated. Stated alternatively, McKinley is not within the scope and content of the prior art that may be used in forming a sec. 103 rejection. Its teachings are therefore not properly combined with the teachings of Harootian and Goff. In the present case, the inventors were concerned with a problem in imaging

sensors, see Background section of the Specification. McKinley has nothing at all to do with imaging sensors, and therefore is not properly within the scope of the prior art. It is therefore not properly applied in rejecting the present claims.

A person reading McKinley would have no teaching that it would be useful to perform a nonlinear mapping on an imaging detector, as recited in claim 6. The nonlinear mapping of an image onto the detector achieves advantageous results discussed in the present application at page 6, line 25-page 7, line 1, and particularly page 6, line 32-page 7, line 1.

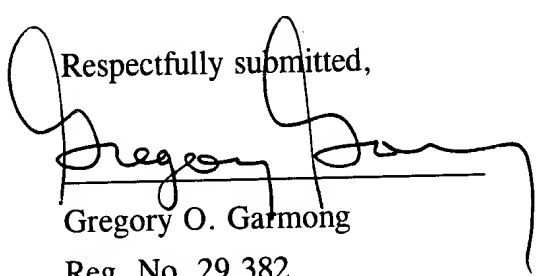
The explanation of the rejection (page 4, last two lines on page) correctly characterizes McKinley as seeking more uniform light through his approach, see col. 4, line 1 where McKinley describes his illustrated device as "homogenizer 10". That of course is not the objective or functionality in an imaging device--one does not seek to achieve more uniform light intensity, because the nonuniformities in the light intensity are what define the nature of the image.

Applicant incorporates the prior discussion of the requirement for an objective basis for combining the teachings of the references. McKinley does not

Applicant asks that the Examiner reconsider and withdraw this ground of rejection.

This paper is filed by the undersigned, who is not presently an attorney of record, pursuant to 37 CFR 1.34(a), MPEP 405, at the instruction of the attorney of record.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

underlined material is to be inserted, [bracketed] material is to be deleted, and --material set off by dashes-- is to be added.

Claims:

--17. The sensor system of claim 1, wherein the detector is an infrared imaging detector.--